



31 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Bradley B. Geist
Baker Botts
30 Rockefeller Plaza
New York, NY 10112-4498

In re Application of
PETER SOPP et al.
Application No.: 09/937,913
PCT No.: PCT/DE00/00837
Int. Filing Date: 17 March 2000
Priority Date: 01 April 1999
Attorney's Docket No.: A34661-PCT-USA
For: GUIDE SYSTEM FOR A ROLLING MILL,
ESPECIALLY FOR A MILL TRAIN

:
:
:
: DECISION ON PETITION
:
:
: UNDER 37 CFR 1.181
:
:

This is in response to applicant's "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action", treated as a petition under 37 CFR 1.181" filed in the United States Patent and Trademark Office (USPTO) on 20 December 2002 alleging that applicant did not receive the Notification of Missing Requirements mailed on 20 November 2001.

BACKGROUND

A review of the application file reveals that the NOTIFICATION OF MISSING REQUIREMENTS was mailed by the USPTO on 20 November 2001. The notification indicated that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and \$130 surcharge for filing the oath or declaration after the thirty month period was required. Applicant was given two months to respond to the Notification or until 20 January 2002 with extensions of time (up to 5 months) available under 37 CFR 1.136(a). No response to the Notification of Missing Requirements was received, and thus, the application was held to be **ABANDONED** as of midnight on 22 June 2002 (20 June 2002 was a Saturday and 21 June 2002 was a Sunday).

On 13 November 2002, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicant.

DISCUSSION

In order to establish that papers were not received, a petition under 37 CFR 1.181 with a

proper showing is required. As set forth in the Official Gazette at 1156 OG 53, the petition must include the following: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket records must also be referenced in practitioner's statement). No petition fee is required.

Items (1) and (2) are satisfied by the practitioner's statement that the Office action was not received by the practitioner and his statement attesting that a search of the file jacket and docket records indicated that the Office action was not received.

With regard to Item (3), applicant submitted a copy of the "attorney's docket notices for the two month and six month dates, i.e. 20 January 2002 and 20 May 2002". With a five month extension of time available, the relevant date is 20 June, not 20 May 2002. This docket record does not exclude the possibility that the "Notification of Missing Requirements" was in fact received by counsel's firm, but inadvertently docketed to the wrong attorney/application. The computer docket record relied upon by counsel establishes only that the Notification was not docketed in connection with his docket, not that such Notification was not received. It is for this reason that the Office generally requires, as the appropriate docket record for establishing nonreceipt of an Office communication, a record of all USPTO responses due on the due date for reply to the communication at issue (i.e., a listing of all replies due in the USPTO on 20 January 2002 for the present case). MPEP 711.03(c), (Rev. 1, Aug 2001) p. 700-140. Counsel does not indicate that the records submitted represent the docket record where the non-received office action would have been entered had it been received.

With regard to Query 2, the law firm's docket record for the month of November 2001 is puzzling as the due dates vary from 2 months to 6 or 7 months for notices mailed in November. Furthermore, although counsel states that the law firm's log reflects every "Missing Requirements" notice received in November 2001, the log itself indicates "Missing Parts". No explanation is provided and a question is raised as to whether this is a query for "Missing Parts" or "Missing Requirements" notices. What is required is as the appropriate docket record for establishing nonreceipt of an Office communication, is a record of all USPTO responses due on the due date for reply to the communication at issue (i.e., a listing of all replies due in the USPTO on 20 January 2002 for the present case).

Thus, applicant has not provided the proper showing necessary to withdraw the holding of abandonment and the petition may not be properly granted at this time.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

The application remains **ABANDONED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Applicant is advised that, effective May 1, 2003, the Office is changing its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK:cmk

Telephone: (703) 306-5467
Facsimile: (703) 308-6459